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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/264,432	03/08/1999	PHILLIP Y. GOLDMAN	14531.46	3073

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EXAMINER
BELIVEAU, SCOTT E

ART UNIT	PAPER NUMBER
2614	11

DATE MAILED: 03/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/264,432	GOLDMAN ET AL.	
	Examiner	Art Unit	
	Scott Beliveau	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4-8,14,15,19 and 33-42* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4-8,14,15,19 and 33-42* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *12 March 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Drawings

1. The corrected or substitute drawings were received on 12 March 2003. These drawings are approved.

Response to Arguments

2. Applicant's arguments with respect to claims 1, 4-8, 14-15, 19, and 33-42 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1, 4-8, 14-15, 19, and 33-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perlman et al. (WO 98/56128), in view of Ballard et al. (US Pat No. 6,182,050), and in further in view of Eldering et al. (US Pat No. 6,457,010).

In reference to claim 1, the Perlman et al. (WO 98/56128) reference shows the schematic structure of a communications network for use with an "information retrieval system" such as the WebTV© client terminal [180] (Figure 1B). The client terminal [180] facilitates shared screen viewing of television/internet content. Subsequently, it handles both the "request" for and "display" of "information documents" or HTML web pages (Page 5, Lines 9-19). The Perlman et al. reference teaches that the embodiment is operable to deliver potentially relevant material during off-peak hours as selected by editorial staff based either on payments or consideration that the items are novel or of general interest (Page 12, Lines 5-21). These advertisements are subsequently inserted from the "advertisement repository being stored at the client system" [220] into the retrieved "information documents" and "displayed" [105] (Page 13, Lines 22-28).

As indicated in the applicant's remarks, the aforementioned Perlman et al. (WO 98/56128) reference does not explicitly disclose, nor preclude, that that the embodiment is operable to "compile a user profile at the client system" (Page 7, Lines 3-10). The Ballard reference discloses an embodiment wherein an "information retrieval system" [14] (Col 5, Lines 41-45, 54-64) may "insert data representing the selected advertisement" based on a "profile of the user of the information retrieval system at the client system" (Col 7, Lines 50-65) which is not "sent to the server computer" [52] for purposes of selecting advertisements to be inserted into information documents which are sent via the server (Col 12, Lines 30-67

– Col 13, Lines 1-41). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Perlman et al. reference, if necessary, to "compile a profile of the user of the information system" as taught by Ballard for the purpose of selecting the most relevant advertisements from the Perlman et al. "repository" [220] in a manner that further protects consumer privacy (Ballard: Col 1, Lines 7-60).

The combined Perlman et al. and Ballard et al. references do not explicitly disclose, nor preclude that the "profile includes at least information associated with television programming". The Ballard et al. reference suggests that the "profile" may monitor "usage" (Col 7, Lines 21-25). The Eldering et al. reference discloses a method for characterizing a subscriber of an "information retrieval system", such as a PC-TV device, (Col 7, lines 1-12) with information that is "stored locally" (Col 6, Lines 66-67 – Col 7, Line 1) and does not necessarily need to be shared (Col 2, Lines 55-67 – Col 3, Lines 1-4). The developed profile may be based "at least information associated with the television programming viewed by the user" (Col 5, Lines 25-35). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the "profile" of the combined Ballard et al. and Perlman et al. references, if necessary, with information pertaining to the "television programming viewed by the user" when using a PC-TV as taught by Eldering et al. Such a modification would advantageously enhance the advertisement affinity ranking of Ballard et al. since a "profile" that characterizes a viewer using both viewing and demographic information, subsequently provides additional dimensions to use when targeting advertisements (Eldering et al.: Col 2, Lines 8-11).

Claim 34 is rejected wherein the aforementioned "system" may be implemented using a "computer program product" (Page 6, Lines 11-17).

Claims 4 and 35 are rejected wherein the "act of inserting data representing the selected advertisement is conducted at the client system" (Perlman et al.: Page 18, Lines 11-20; Ballard et al.: Col 13, Lines 4-25).

Claims 5 and 36 are rejected wherein the Perlman et al. reference teaches that information such as advertisements may be "pre-downloaded" and stored in memory on the client system (Page 12, Lines 15-26; Page 18, Lines 11-20; Figure 5).

Claims 7 and 37 are rejected wherein the "information document" is a web page in HTML format (Perlman et al.: Page 7, Lines 29-31 – Page 8, Lines 1-7).

Claims 8 and 38 are rejected aforementioned wherein the "profile" may be constructed "to further characterize the user" using a combination of user supplied demographic data, and tracking information as illustrated in Figure 1 of the Eldering et al. reference.

In reference to claims 14-15 and 39-40, the Perlman et al. reference discloses that the host server may provide supplemental information including "news" [308] and "reference information related to the content of the television programming" such as sports information provided on ESPN® (Page 11, Lines 24-31 – Page 12, Lines 1-2).

Claims 19 and 41 are met wherein the Perlman et al. reference discloses that information may be "pushed" to the client during off-peak periods (Figure 5; Page 12, Lines 18-21; Page 20, Lines 14-30). It is well known in the art that "push" technology does not require "direct user assistance".

Claims 33 and 42 are rejected wherein the compiling of a "profile includes an act of identifying closed captioning received from television programming" (Eldering et al.: Col 5, Lines 36-46).

6. Claims 1, 4-8, 14-15, 19, and 33-42 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Perlman et al. (WO 98/56128), in view of Newman et al. (US Pat No. 6,085,229), and in further in view of Eldering et al. (US Pat No. 6,457,010).

In reference to claim 1, the Perlman et al. (WO 98/56128) reference shows the schematic structure of a communications network for use with an "information retrieval system" such as the WebTV© client terminal [180] (Figure 1B). The client terminal [180] facilitates shared screen viewing of television/internet content. Subsequently, it handles both the "request" for and "display" of "information documents" or HTML web pages (Page 5, Lines 9-19). The Perlman et al. reference teaches that the embodiment is operable to deliver potentially relevant material during off-peak hours as selected by editorial staff based either on payments or consideration that the items are novel or of general interest (Page 12, Lines 5-21). These advertisements are subsequently inserted from the "advertisement repository being stored at the client system" [220] into the retrieved "information documents" and "displayed" [105] (Page 13, Lines 22-28).

The Newman et al. reference discloses a method for personalizing "information documents" such as web pages using based on "personal information" or a "profile" which is "stored at the client system without being sent to the server computer for purposes of selecting advertisements to be inserted into information documents" (Col 4, Lines 31-40). Accordingly, it would have been obvious to one of ordinary skill in the art to utilize

personalization teachings of Newman et al. when "selecting" advertisements "at the client system" using the off-peak delivered information from the "advertisement repository" of Perlman et al. for the purpose of targeting advertisement while maintaining the privacy of client side personal information (Newman et al.: Col 2, Lines 11-25).

The Newman et al. reference does not explicitly disclose what the "personal information" or "profile" may comprise. The Eldering et al. reference discloses a method for characterizing a subscriber of an "information retrieval system", such as a PC-TV device, (Col 7, lines 1-12) with information that is "stored locally" (Col 6, Lines 66-67 – Col 7, Line 1) and does not necessarily need to be shared (Col 2, Lines 55-67 – Col 3, Lines 1-4). The developed profile may be based "at least information associated with the television programming viewed by the user" (Col 5, Lines 25-35). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the "profile" of Newman et al., if necessary, with information pertaining to the "television programming viewed by the user" when using a PC-TV, as taught by Eldering et al., for the purpose utilizing a "profile" which characterizes a viewer using both viewing and demographic information in order to provide additional dimensions to accurately target advertisements (Eldering et al.: Col 2, Lines 8-11).

Claim 34 is rejected wherein the aforementioned "system" may be implemented using a "computer program product" (Page 6, Lines 11-17).

Claims 4 and 35 are rejected wherein the "act of inserting data representing the selected advertisement is conducted at the client system" (Perlman et al.: Page 18, Lines 11-20; Ballard et al.: Col 13, Lines 4-25)

Claims 5 and 36 are rejected wherein the Perlman et al. reference teaches that information such as advertisements may be "pre-downloaded" and stored in memory on the client system (Page 12, Lines 15-26; Page 18, Lines 11-20; Figure 5).

Claims 7 and 37 are rejected wherein the "information document" is a web page in HTML format (Perlman et al.: Page 7, Lines 29-31 – Page 8, Lines 1-7).

Claims 8 and 38 are rejected aforementioned wherein the "profile" may be constructed "to further characterize the user" using a combination of user supplied demographic data, and tracking information as illustrated in Figure 1 of the Eldering et al. reference.

In reference to claims 14-15 and 39-40, the Perlman et al. reference discloses that the host server may provide supplemental information including "news" [308] and "reference information related to the content of the television programming" such as sports information provided on ESPN® (Page 11, Lines 24-31 – Page 12, Lines 1-2).

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Claims 33 and 42 are rejected wherein the compiling of a "profile includes an act of identifying closed captioning received from television programming" (Eldering et al.: Col 5, Lines 36-46).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

- The Kramer et al. (US Pat No. 6,327,574) reference discloses a system and method for the insertion of individualized content in retrieved web documents based on a locally stored profile.
- The Voyticky et al. (US Pat No. 6,438,751) reference discloses a method and apparatus that enables a user to store event information while watching a television broadcast which is subsequently utilized to retrieve internet information.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-4907. The examiner can normally be reached on Monday-Friday from 8:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

SEB
March 20, 2003

JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600